

REMARKS

Claims 3, 20-30, 33, 34, 37, 38, 41, and 42 are pending in the present application.

At the outset, Applicants wish to thank the Examiner for the indication that Claims 3 and 20-23 remain allowable (see paragraph 10 on page 10 of the Office Action dated January 19, 2007). Applicants also request withdrawal of the outstanding rejections in view of the amendments above. In Claims 3 and 20 to 23, the term "peptide" has been replaced with "compound". This is because these claims are dependent on Claim 24 which relates to a compound (not a peptide).

The rejection of Claims 24-41 under 35 U.S.C. §112, first paragraph (enablement), is obviated in part by amendment and traversed in part.

At the outset, Applicants note that Claims 31, 32, 35, 36, 39, and 40 are canceled herein. Further, the following amendments have been made:

(1) Claim 24 has been amended to define R7 as: "R7 represents a side chain of an amino acid having a hydrophobic side chain selected from the group consisting of valine, norvaline, leucine, norleucine, isoleucine, phenylalanine, phenylglycine, threonine, and tryptophan", which Claim 25 has been amended to define R7 as: "R7 represents a side chain of a neutral amino acid having a hydrophobic side chain selected from the group consisting of valine, norvaline, leucine, norleucine, isoleucine, phenylalanine, phenylglycine, and threonine".

(2) Claim 24 has been amended to define R4 as: "R4 represents an unsubstituted basic amino acid side chain", while Claim 25 has been amended to define R4 as: "R4 represents an unsubstituted basic amino acid side chain having an amino group or a guanidino group".

(3) Claim 24 has been further amended as follows:

X1 represents an unsubstituted alkylene group having 1 to 6 carbon atom,

X2 represents a single bond,

X3 represents –NR<sup>10</sup>–,

R9 represents a hydrogen atom, an acyl group having 2 to 22 carbon atoms, or  
an alkyl group having 1 to 22 carbon atoms,

m is the integer 1.

Note: Ar, R1 to R3, R6, R8, R10, R11, and, n each is maintained as it is.

(4) Claims 26, 27, and 38, have been amended to replace the phrase “, and a pharmaceutically acceptable carrier” with “and a cosmetically acceptable carrier” based on page 20, line 13 to page 23, line 1.

(5) In Claim 24, the phrase “having a naphthyl group and” has been deleted as being superfluous.

In view of the amendments set forth herein, when coupled with the description provided in the specification and further supported by the Shiojiri & Takino Declaration, Applicants respectfully submit that the skilled artisan would be fully enabled to make and use the full scope of claimed compounds. In recognition of the same, Applicants submit that the claimed invention is in full compliance with the enablement requirement of 35 U.S.C. §112, first paragraph.

Applicants believe that these amendments address the substantial share of the Examiner criticisms. However, Applicants wish to specifically comment on two remaining issues.

First, in Claim 24 the definition of “Ar” has been maintained. Although the Examiner considers just compounds which Ar is an *unsubstituted* naphthyl group are enabled,

Applicants submit that Ar is disclosed concretely at page 10, line 15 to 24 of the specification. In view of this disclosure, Applicants submit that the skilled artisan would readily appreciate how to prepare substituted naphthyl compounds. Therefore, the skilled artisan would readily appreciate how to practice the claimed invention based on the present disclosure without undue experimentation.

Second, with respect to Claims 30, 34 (a method of whitening) and Claim 38 (a whitening agent), Applicants have limited the scope of these claims to define the whitening agent has exhibiting inhibition of pigmentation by ultraviolet rays. Support for the enablement of these claims is provided by the demonstrated effect of suppressing pigmentation in Test Example 4 and the specification at page 18, line 17 to 22, in particular the phrase which states “particularly preferred are those inhibiting pigmentation by ultraviolet rays for employing as a whitening agent”. From this section of the specification and Test Example 4, Applicants submit that the skilled artisan would fully appreciate the scope of the invention of Claims 30, 34, and 38 based on the specification and could practice the same without undue experimentation.

In view of the foregoing, Applicants submit that the full scope of the presently claimed invention is sufficiently enabled as required by 35 U.S.C. §112, first paragraph. As such, Applicants request withdrawal of this ground of rejection.

The rejection of Claims 24-26, 38, and 41 under 35 U.S.C. §102(b) over Janecka et al is obviated by amendment.

In claim 24 and 25, the definition of R7 has been amended to be a side chain of an amino acid having a hydrophobic side chain selected from the group consisting of valine, norvaline, leucine, norleucine, isoleucine, phenylalanine, phenylglycine, threonine, and

tryptophan. In so doing, compound 29, Ac-D-Nal-Arg-D-Ala-NH<sub>2</sub>, and Nal-Gly-Gly-NH<sub>2</sub> disclosed by Janecka et al are excluded from the scope of the claimed invention. Since Janecka et al fail to disclose a compound within the scope of the invention presently claims, this reference cannot anticipate the claimed invention.

In view of the foregoing, Applicants request withdrawal of the rejection over Janecka et al. Acknowledgment to this effect is requested.

The objection to Claim 24 based on the definition of “m” is obviated by amendment. Applicants have amended Claim 24 as suggested by the Examiner to delete reference to m being equal to 0. Withdrawal of this ground of objection is requested.

Finally, Applicants respectfully note that errors have been identified in the Declaration under 37 C.F.R. §1.132 executed by Dr. Eiji Shiojiri and Dr. Yoshinobu Takino (“the Shiojiri & Takino Declaration”) on June 19, 2006 and filed on June 21, 2006. In the Table appearing on pages 11-12 of the Shiojiri & Takino Declaration, the following errors were identified, which are corrected in the Table appearing in the new Declaration under 37 C.F.R. §1.132 executed by Dr. Eiji Shiojiri and Dr. Yoshinobu Takino **submitted herewith**:

(i) R1 in example 1 to 4, compound 1 to 7, and 12 each is hydrogen atom (not methyl group),

(ii) X1 in example 1 to 4 and compound 1 to 7 each is methylene (not single bond). The foregoing is because the naphthyl group is attached on the methyl side chain of alanyl group in “Nal” in formula (1). Furthermore, there is support that R1 represents a hydrogen atom, and X1 is a methylene group in claim 25, and

(iii) R7 in Compound 8 and R4 in Compound 15 are Nle SC (i.e., norleucine side chain) rather than butyl. The error and the corresponding correction is clear from the description in the structure column in the Table, as well as the synthesis described in section (D).

Applicants further submit that the new Shiojiri & Takino Declaration still supports the notion that the specification as filed fully describes the scope of the claimed invention in accordance with the standard of *In re Gostelli* for all the reasons set forth on pages 14-19 of the Amendment and Request for Reconsideration filed on November 7, 2006.

Applicants submit that the present application is now in condition for allowance.  
Early notification of such action is earnestly solicited.

Respectfully submitted,

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